



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 4450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,839	06/30/2000	Michael A. Cleron	14531.70	2344
47973	7590	10/20/2005	EXAMINER	
WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			DENNISON, JERRY B	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/607,839

Applicant(s)

CLERON ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-15, 27, 28 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15, 27, 28 and 30-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Action is in response to Amendment for Application Number 09/607,839 received on 26 July 2005.
2. Claims 1-10, 12-15 and 27, 28, 30-35 are presented for examination.
3. Claims 11 and 29 have been cancelled.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation, "the server application generating and sending a request to a decision engine, which –is separate". The limitation includes the typo "-is". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 and 27-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 recites the limitation "the server application generating and sending a request to a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, which the decision engine has access to, wherein the request sent from the server application to the decision engine specifies that the decision engine is to identify appropriate content for a

particular client on whatever decision criteria are available to the decision engine, and such that the request is sent, without specifying either the at least one attribute of the client or how the selection of content is to be made.”

It is unclear to the Examiner how the decision engine knows to select content based on a client attribute if the request does not supply the client attribute and also if the request does not specify how the selection is to be made. It is unclear what the request actually includes and also how the decision engine is using it. It is also unclear how the decision engine would know that the request for content is based a particular client without receiving any indication of the client from the server application. Examiner suggests rephrasing this limitation in a more clear and precise manner explaining what the invention **does** use or do rather than what it does not use or do, and also excluding any negative limitations to allow the examiner to perform a proper search and consideration on the claimed invention. Examiner interprets the claim as **contradicting** itself by saying “generating and sending a request to a decision engine...to select content...based on at least one attribute of the client”, (which says that the **request includes some kind of client identifier** and the decision engine selects content based on that identifier), and then, later on it says, “such that the request is sent without specifying either the at least one attribute of the client”, (which says that there is **no identifier in the request**). Examiner is unclear how to interpret the claim. Examiner feels that the claimed invention is not clearly pointed out.

Examiner strongly suggests explaining what **is** in the request to the decision engine. If there is nothing in the request identifying the client, then explain how the

decision engine knows what client attributes to use. How does the decision engine know what client to base retrieving data on?

6. Claims 9 and 27 recite the limitation "only upon processing a first portion of a script associated with the document, issuing to a decision engine, that is separate from the server application, a request for the decision engine to select a second portion of the script, wherein the selection of the second portion is based on at least one client attribute that is identified by the decision engine and that is not included with the request or script".

It is unclear to the Examiner how the decision engine identifies a client attribute without receiving a client identifier in the request or script. It is unclear to Examiner how the decision engine makes a selection **based on a client attribute** without receiving the client attribute. It is unclear where this attribute comes from if it is not in the request. It is also unclear what the request includes. It is suggested by the Examiner to explain what the request **does** include rather than what it does not include to allow the examiner to perform a proper search and consideration on the claimed invention.

The same problems from claim 1 also appear in claims 9 and 27. Appropriate correction is required.

7. Claim 14 recites the limitation "the at least one attribute of the client that is to be used by the decision engine to select the second portion." It is unclear to Examiner how the decision engine identifies the at least one attribute of the client. It is unclear how the

Art Unit: 2143

decision engine receives this client attribute as well, if it is not included in the request from the server application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 and 27-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Courts et al. (U.S. 6,076,108).

8. Regarding claims 1, 9, 12, 13, and 27, Courts disclosed in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

receiving a request for a document at a server application, the server application being configured to generate the document from a script;

the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, which the decision engine has access to, wherein the

Art Unit: 2143

request sent from the server application to the decision engine specifies that the decision engine is to identify appropriate content for a particular client on whatever decision criteria are available to the decision engine, and such that the request is sent, without specifying either the at least one attribute of the client or how the selection of content is to be made;

wherein the decision engine, upon receiving the request, accesses the at least one attribute of the client from an attribute provider and uses the at least one attribute of the client to select content that the decision engine determines to be appropriate for the client from a plurality of available content, and wherein the decision engine sends identification of the selected content to the server application;

the server application receiving from the decision engine an identification of the content that has been selected by the decision engine; and

transmitting the document to the client (Courts, col. 7, line 45 through col. 8, line 30, Courts disclosed a server implementation where a render engine receives a request from a client, the render engine associating a session ID with the client, the render engine sending the session ID of the client to a session manager to request session information for the SID, the information being passed back to render engine, and the render engine creating the document and transmitting it to the client. The original client request is not being passed to the session manager. The render engine request includes a client session ID, which identifies the client, but does not include any attributes of the client or how to select content. Based on the id, a selection of content is made).

9. Regarding claim 2, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein the act of receiving the identification of the content comprises the act of receiving script that, when executed, results in the content being incorporated into the document (Courts, col. 8, lines 25-30).

10. Regarding claim 3, Courts disclosed the limitations, substantially as claimed, as described in claim 2, including the act of assembling the script at runtime by concatenating said script and said additional script (Courts, col. 8, lines 45-50).

11. Regarding claims 4 and 5, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein:

the act of processing code associated with the script is performed by a server application operating at the server (Courts, col. 8, lines 45-50).

12. Regarding claim 6, Courts disclosed the limitations, substantially as claimed, as described in claim 4, including wherein the document is a web page (Courts, col. 7, lines 28-33).

13. Regarding claims 7 and 8, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein the content comprises at least one of text and an image (Courts, col. 7, lines 28-33, Courts disclosed the



Art Unit: 2143

document including web content, which are text and images) and wherein the content comprises formatting content (Courts, col. 8, lines 25-31, 43-48).

14. Regarding claim 10, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27. Claim 10 is nothing more than repeating the functionality of claim 9 with a third portion of the script. Therefore, claim 10 is rejected by the same art as claim 9 as being substantially similar.

15. Regarding claim 14, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including the act of the decision engine selecting the second portion of the script, including:

identifying, independently of a server application that executes the script, decision criteria that are to be used by the decision engine to select the second portion (Courts, col. 8, lines 35-45);

identifying, independently of a server application, the at least one attribute of the client that is to be used by the decision engine to select the second portion (Courts, col. 8, lines 35-45).

16. Regarding claim 15, Courts disclosed the limitations, substantially as claimed, as described in claim 14, including wherein the act of the decision engine selecting the second portion of the script further includes applying the decision criteria to the at least

one attribute to select said second portion of script from among a plurality of portions of script (Courts, col. 8, lines 30-45).

17. Claims 28, 30-33 include limitations substantially similar to the limitations of claims 1-15 and are therefore rejected by the same prior art used in the rejections of claims 1-15 as being substantially similar.

18. Regarding claim 34, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein the decision engine includes decision criteria for identifying the content and wherein the server application is configured without the decision criteria that are used to identify the content (Courts, col. 8, lines 30-45).

19. Regarding claim 35 Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein changes can be made to the decision criteria without altering code of the server application (Courts, col. 7, lines 30-45).

Claims 1-15 and 27-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Gebauer (U.S. 6,662,343).

20. Regarding claims 1, 9, 12, 13, and 27, Gebauer disclosed in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

receiving a request for a document at a server application, the server application being configured to generate the document from a script;

the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made;

the server application receiving from the decision engine an identification of the content that has been selected by the decision engine; and

transmitting the document to the client (Gebauer, Fig 5, col. 9, Abstract, Gebauer disclosed web server software **96** that receives a request from a client, the web server software **96** making a request through the Cool ICE Gateway **100** to the Service Handler **102**, which identifies content data/scripting from the Cool ICE Repository **106** and Cool Ice Scripting **108**, and generates web content, which is sent back to the web server software **100**, the web server software combining the content to form a complete response to the user).

### **Response to Amendment**

Applicant's arguments and amendments filed on 26 July 2005 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations into the independent claims, which will require further search and consideration*) to the claims which significantly affected the scope thereof.

Applicant's arguments with respect to claims 1-10, 12-15 and 27, 28, 30-35 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant explains that the "decision engine has access to the attribute independently of the server application, such that the request sent from the server application to the decision engine merely needs to specify that the decision engine is to identify appropriate content for a particular client on whatever decision criteria are available to the decision engine" [see Applicant's response, page 9, last paragraph, continuing on page 10].

Examiner interprets this as the request includes some identifier of the client, and the decision engine uses this identifier with its decision criteria to decide what content to choose. The decision engine has access to this content independently of the server application.

Applicant also explains that the "decision engine, upon receiving the request, access the attribute of the client from an attribute provider". This is not included in the

Art Unit: 2143

claimed invention. If this were to be added in the claims, Examiner strongly suggests what this attribute provider is and how it receives the attribute of the current client.

Applicant also explains "it should now be apparent what the request from the server application includes and that the decision engine is able to make the decision regarding what content to select based on an attribute without receiving it in the request." Examiner disagrees at this point. Examiner suggests Applicant to refer to the current 112 rejection above.

Applicant's arguments include the failure of previously applied art to expressly disclose the teachings "a method or system in which a client engine selects content from a plurality of content that is appropriate for a client based on an attribute of the client that is not included in the request for content received from a separate server application and that is used to customize a web document [see Applicant's Response, Paper#7 page 11 of 12]. It is evident from the mappings found in the above rejection that Courts disclosed the teaching of a render engine requesting data from a session manager and the session manager providing the data for that session server (Courts, col. 7, line 45 through col. 8, line 30). Court also taught that a broker makes a connection through the local session cache to the session cache on a computer where the master copy of session data is stored (Courts, col. 8, lines 35-45). Further, it is clear from the numerous teachings (previously and currently cited) that the provision for using "a decision engine to provide content" was widely implemented in the networking art.

As it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

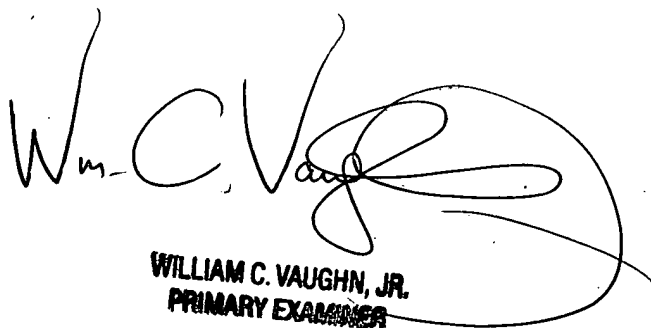
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. B. D.  
Patent Examiner  
Art Unit 2143



**WILLIAM C. VAUGHN, JR.**  
**PRIMARY EXAMINER**